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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/127,571	07/31/1998	PAILY VARGHESE	COMP:0016	1413

1200 7590 11/19/2002

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EXAMINER

TRAN, KHOA H

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 11/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/127,571

Applicant(s)

VARGHESE ET AL.

Examiner

Khoa Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 33-51 is/are pending in the application.
- 4a) Of the above claim(s) 49-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/17/2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

***Continued Prosecution Application***

The request filed on September 03, 2002 for a Request Continued Examination (RCE) under 37 CFR 1.114 based on the parent Application No. 09/127,571 is acceptable and an RCE has been established. An action on the RCE follows.

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 33-48 are drawn to a computer component rack mounting system, classified in class 211, subclass 26.
- II. Claims 49-51 are drawn to a method of mounting a computer component classified in class 361, subclass 679.

The inventions are distinct, each from the other because of the following reasons:

Inventions of Group II, as claimed, and Group I, as claimed are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed could be made by another process that does not require the rail assembly to have the first and second portions telescoping rails and the process as claimed can be used to make other materially different product of the mounting computer that does not require the telescoping rail assembly that recesses outwardly within the support member recess.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Accordingly, the newly submitted method claims of 49-51 are directed to an invention that is independent or distinct from the apparatus claimed invention that was originally filed and examined in the parent application No. 09/127,571. Since the applicants have received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 49-51 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the second telescoping rail cannot extend beyond the pair of vertical rack member" in claims 35 and 46 must be shown or the features canceled from the claims. No new matter should be entered. A proposed drawing correction or corrected drawings are required in reply to the Office action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 35 and 46 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter of "the second telescoping rail cannot extend beyond the pair of vertical rack members" set forth in claims 35 and 46 are considered to constitute new matter because there is no disclosure in the original specification describing that the telescoping rail cannot extend beyond the rack (16) and/or beyond the vertical rack member (110). Applicants are required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 33, 36-38, 43, and 44, are rejected under 35 U.S.C. 102(b) as being anticipated by Good et al. ('256). Good et al. ('256) disclose a mounting system (10) for a computer component rack comprising:

a support member (52) comprises a pair of attachment members (54a and 54b) attached to a pair of vertical rack members (14a, 16a), see Figure 3;

a support rail (44), positioned between the pair of attachment members (52a and 54b) and recessed outwardly, forming a support member recess between the pair of vertical rack members (14a and 16a) when the support member (52) is attached to the pair of vertical rack members;

a telescoping rail assembly (50), mountable to the support rail (44) within the support member recess, such that a portion of the telescoping rail assembly is recessed outwardly within the support member recess, see Figure 2;

a first telescoping rail (48) mounted to a recess formed in a side near the bottom (30) of a computer component enclosure (22) such that the computer component enclosure can slide in and out of the mounting system (10), see Figure 1.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 35, 39, 45, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al. ('256) as applied to claims 33, 36-38, 43, and 44 above, and further in view of Fall ('690). Fall ('690) teaches the rail assembly comprising a first rail that has the outer rail (47) and an inner rail (58) that mount to a second rail that has the outer rail (40) and an inner rail (55), wherein the first outer rail (47) is fixedly mounted to the second inner rail (55) and the inner rails (55 and 58) are movable along

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the fixed outer rails (40 and 47). See Figure 2. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to provide the rail assembly of Good et al. ('256) with the rail assembly as taught by Fall ('690) in order to have the rail assembly that has at least one channel members constitutes a part of the intermediate element of the slide structure to improve the resistance to the vertical bending stress. Further, it should be noted that the second telescoping rail (40) when mounted to the support rail (44), it would prevent the second outer rail from extending beyond the pair of the vertical rack members because the second outer rail is fixed to the support rail.

Claims 40-42, 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Good et al. ('256) in view of Fall ('690) as applied to claims 33-39 and 43-46 above, and further in view of Fall et al. ('505). Fall et al. ('505) teach the support rail (10) that is twice the size or twice the height of the rail assemblies (12), which are mountable to the support rail upper and lower portions. See Figure 1. It would have been obvious to one of ordinary skill in the art at the time of invention was made to provide the modified mounting system of Good et al. ('256) with the provision of the support rail that is twice the size or twice the height of the rail assembly as taught by Fall et al. ('505) in order to provide a choice of mounting the rail assembly on either the upper portion or the lower portion on each side of the support rail so that to suitable the desire arrangement of the computer component enclosure mounts thereon the rack.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa Tran whose telephone number is (703) 306-3437.

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The examiner can normally be reached on Monday through Thursday from 8:30 A.M. to 7:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola, can be reached on (703) 308-2686. The fax phone number for this Group is (703) 305-3597 or (703) 305-3598.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

If the applicant is submitted by facsimile transmission, applicant is hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and M.P.E.P. 502.02). In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (M.P.E.P 512). The following is an example of the format the certification might take:

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Type or printed name of person signing this certificate:

\_\_\_\_\_

(Signature)

Furthermore, please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Khoa Tran  
November 15, 2002

A handwritten signature in cursive script that reads "Daniel P. Stodola". The signature is written in dark ink and is positioned to the right of the date and name of Khoa Tran.

DANIEL P. STODOLA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600